

REMARKS

This responds to the Office Action mailed on May 18, 2005. No claims are amended or cancelled. Claims 1-23 remain pending in this application.

§102 Rejection of the Claims

Claims 12-13 and 15-17 were rejected under 35 U.S.C. § 102(b) for anticipation by Kinstler (U.S. 5,005,306). Applicant respectfully traverses the rejection for at least the following reasons.

The rejection states that “Kinstler discloses an illuminated vehicle sign providing a pattern to convey a visual safety message.” Kinstler appears to show an electroluminescent display “for displaying advertising material or the like at night during low light periods to allow a better visibility of the advertising material” (col. 1, lines 53-55). Kinstler does not show a pattern selected to convey *a visual safety message*. Applicant acknowledges the contention on Page 3, among other locations, in the present Office Action that “signs are intended to convey messages, whereby a safety sign does not attain any unique status. Thus, Kinstler's advertising sign could easily portray and advertise a warning or safety message.” Nonetheless, Kinstler does not show a pattern selected to convey a visual safety message. Applicant will address why such a configuration and method is non-obvious in arguments presented below.

Because the Kinstler reference does not show every element of independent claim 12, a 35 USC § 102(b) rejection is not supported. Reconsideration and withdrawal of the rejection are respectfully requested with respect to Applicant's independent claim 12, and claims 13, 15-17 that depend therefrom as depending on an allowable base claim.

§103 Rejection of the Claims

Claims 1-11, 14, and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Kinstler in combination with various additional references. Applicant respectfully traverses the rejection for at least the following reasons.

Regarding claims 1-7, the rejection states that Kinstler discloses a sign formed into a chosen pattern and a vehicle(10) on which the sign is attached. The rejection further states that ‘Kinstler does not specifically teach the method wherein safety signs are visible to provide

guidance for the vehicles.” Applicant agrees that Kinstler does not show this method. The rejection, however, further states that “it would have been obvious to one ordinarily skilled in the art at the time of invention to provide safety signs on the vehicles for guidance purposes, since it has been held that method claims are unpatentable when the prior art recites all structural limitations of said claims.”

Applicant respectfully traverses the statement that “it has been held that method claims are unpatentable when the prior art recites all structural limitations of said claims.” MPEP §2112.02 states that “if a prior art device, *in its normal and usual operation* (emphasis added), would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device.”

Applicant again notes that although Kinstler appears to show an electroluminescent display “for displaying advertising material or the like at night during low light periods to allow a better visibility of the advertising material,” Applicant is unable to find vehicle formations, snowplows, or using an EL lighting surface to provide guidance for vehicles in Kinstler. Applicant respectfully submits that these method steps as recited in the claims are not a normal use and usual operation of devices shown in Kinstler.

In contrast, independent claims 1 and 2 include driving one or more vehicles in a formation on the road wherein the safety signs are visible to provide guidance for the vehicles. Because Kinstler does not show every element of Applicant’s independent claims, a 35 USC § 102(b) rejection is not supported. Reconsideration and withdrawal of the rejection is respectfully requested with respect to Applicant’s independent claims 1 and 2. Additionally, reconsideration and withdrawal of the rejection is respectfully requested with respect to claims 3-7 that depend therefrom, as depending on an allowable base claim.

Independent claims 8, 12, and 22 includes elements wherein a pattern is selected to convey a visual safety message. The present Office Action states on page 3, among other locations, that “signs are intended to convey messages, whereby a safety sign does not attain any unique status. Thus, Kinstler’s advertising sign could easily portray and advertise a warning or safety message.” Applicant respectfully traverses the assertion that portraying a safety message using EL devices as claimed is obvious.

MPEP § 2143, discussing the Graham v. Deere factual inquiries, states that “objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence.” In support of Applicant’s assertion of non-obviousness, Applicant has attached an Affidavit of John T. Golle, Chief Executive Officer of Safe Lites, LLC. The affidavit provides objective evidence that selecting a pattern to convey a visual safety message is non-obvious. Evidence provided in the affidavit specifically concerns a slow moving vehicle (SMV) safety message, however, Applicant respectfully submits that the objective evidence shows non-obviousness of safety messages in general.

Because under the Graham v. Deere factual inquiries, claims 8, 12, and 22 include elements which are novel and non-obvious, a 35 USC § 103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to Applicant’s independent claims 8, 12, and 22. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to the remaining claims that depend therefrom as depending on allowable base claims.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

AARON GOLLE ET AL.

By their Representatives,

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Date

9-16-05

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of September, 2005.

Name

KACIA LEE

Signature

